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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/975,417	10/10/2001	Paul Swift	34580.001CC	9594

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EXAMINER

LUONG, VINH

ART UNIT	PAPER NUMBER
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3682

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DATE MAILED: 01/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/975,417

Applicant(s)
SWIFT

Examiner
Luong

Art Unit
3682



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Vinh T. Luong
Primary Examiner

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: *Exhibit*

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1. The use of the trademarks, such as, LOOK, SPEEDPLAY, and BE-BOP has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

2. The following guidelines illustrate the preferred layout and content for patent applications. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

The following order or arrangement is preferred in framing the specification and, except for the reference to the drawings, each of the lettered items should appear in upper case, without underlining or bold type, as section headings. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) Title of the Invention.
- (b) Cross-Reference to Related Applications.
- (c) Statement Regarding Federally Sponsored Research or Development.
- (d) Reference to a "Sequence Listing," a table, or a computer program listing appendix submitted on compact disc (see 37 CFR 1.52(e)(5)).
- (e) Background of the Invention.
 - 1. Field of the Invention.
 - 2. Description of the Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (f) Brief Summary of the Invention.
- (g) Brief Description of the Several Views of the Drawing(s).
- (h) Detailed Description of the Invention.
- (i) Claim or Claims (commencing on a separate sheet).
- (j) Abstract of the Disclosure (commencing on a separate sheet).
- (k) Drawings.
- (l) Sequence Listing, if on paper (see 37 CFR 1.821-1.825).

3. The disclosure is objected to because of the following informalities: the disclosure:

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(a) should be arranged in the order listed above, *e.g.*, the description of the prior art Figs. 11-17, *etc.*, should be arranged in the Description of the Prior Art, not in the Detailed Description of the Preferred Embodiments. See, *e.g.*, page 28 *et seq.* of the specification; and

(b) contains typographical or spelling error, *e.g.*, "The flip-flip bicycle pedal 570" in line 21 on page 30 of the specification should have been "The flip-flop bicycle pedal 570."

Appropriate correction is required.

4. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

5. Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear whether:

(a) the term that appears at least twice such as "a toe cleat clamp" in claim 1 refers to the same or different things. Applicant is respectfully urged to identify each claimed element with reference to the drawings; and

(b) a confusing variety of terms such as: (1) "a *road* type bicycle shoe cleat" and "a *mountain* bicycle type shoe cleat" in claims 1 and 2; and (2) "a bicycle road shoe cleat" and "a *mountain* bicycle shoe cleat" in claim 3 refer to the same or different things. See MPEP 608.01(o).

Applicant is respectfully urged to identify each claimed element with reference to the drawings

The terms, such as, (a) "a *road* type bicycle shoe cleat" and "a *mountain* bicycle type shoe

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cleat” in claims 1 and 2; and (b) “a bicycle road shoe cleat” and “a *mountain* bicycle shoe cleat” in claim 3 are vague and indefinite since there is no objective standard to define which type of shoe is a road type or a mountain type. Common sense teaches that the road type shoe inherently can be used to ride the mountain bike, *i.e.*, the road type shoe may become a mountain type shoe, or *vice versa*. Moreover, any kind of shoe inherently can be worn by a bicyclist to ride a mountain bike, a road bike, or to walk on a street. In addition, a regular shoe can also be a road bike shoe or mountain bike shoe. It would be impossible to determine whether a particular pedal is covered by applicant’s claims since with regard to the *road* type bicycle shoe cleat, *mountain type* bicycle shoe cleat, *etc.*, whether or not the particular pedal falls within language of the claims would depend upon subjective determinations such as the location of the bicycle, the intended use of the user/bicyclist, or the habit of riding the bicycle of a particular rider on the road or the mountain. See *Ex parte Brummer*, 12 USPQ2d 1653, 1655 (BPAI 1989).

No antecedent basis is seen for the term, such as, “the rear spring-loaded retaining *plate* of said bottom side” in claim 1.

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351 (a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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7. Claims 1-4, as best understood, are rejected under 35 U.S.C. 102(e) as being anticipated by Gapinski *et al.* (US Patent No. 6,035,743 filed on March 18, 1998 and cited in applicant's parent application Serial No. 09/360,561).

At the outset, note that this application is a Continuation-in-Part (CIP) of application Serial No. 09/360,561 (SN'561) filed on May 26, 1999 which is a CIP of application Serial No. 08/923,022 (SN'022) filed on September 3, 1997. Only the common part of this application and SN'022 are entitled to the filing date of September 3, 1997. See MPEP 201.08. Since applicant now claims, *e.g.*, "a rear spring-loaded retaining plate" which is not disclosed in SN'022, therefore, the claims in this application are not entitled to the filing date of SN'022. In other words, since: (a) the claims in this application are drawn to new Figs. 18-22 of this application as described on page 30 *et seq.* of the specification; and (b) these new Figs. 18-22 were not disclosed in SN'022 and SN'561, therefore, these claims are entitled to the filing date of October 10, 2001 of this application only. The US Patent No. 6,035,743 was filed on March 18, 1998, *i.e.*, before the filing date of October 10, 2001 of this application and before the filing date of May 26, 1999 of the parent application SN'561. Thus, Pat.'743 is qualified under 35 USC 102(e) to reject the claims in this application.

Regarding claim 1, Gapinski teaches a flip-flop bicycle pedal, comprising:

a. a main body 24 pivotable about a transverse axis and having a spindle bolt 32 for connecting to a bicycle, a top side 28 and a bottom side 31 (*id.*, line 7 *et seq.*, column 3);

b. said top side 28 having a toe cleat clamp 26 which conforms to a bottom of a road type bicycle shoe cleat, the toe cleat clamp 26 having a front recess 100, 106 (Fig. 3) for receiving a front tongue (see attached Exhibit) of the road type bicycle shoe cleat 22 and a rear spring-loaded

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retaining plate 42 (see spring 112 in Figs. 5 and 8) pivotable on said main body 20, the rear spring-loaded retaining plate 42 having a recess 144 for receiving a rear tongue 46 of the road type bicycle shoe cleat 22 and when a force is applied to the spring-loaded retaining plate 42, the spring-loaded retaining plate 42 moves away from said main body 20 such that the rear tongue 46 engages the recess of the spring-loaded retaining plate 42, where the spring-loaded retaining plate 42 springs back into a locking position, and thereby locks the rear tongue 46 of the road type bicycle shoe cleat 22 thereto; and

c. said bottom side 31 having a toe cleat clamp 30 which is smaller than said toe cleat clamp 26 of said top side 28 and conforms to a bottom of a mountain bicycle type shoe cleat, the toe cleat clamp 30 of said bottom side 31 having a front locking member 30 located adjacent to said rear spring-loaded retaining plate 42 of said top side 28 for receiving a front tongue of the mountain bicycle type shoe cleat and a rear spring-loaded retaining member (see attached Exhibit) pivotable on said main body 24 such that a rear tongue of the mountain bicycle type shoe cleat engages inside a recess of the rear spring-loaded retaining plate of said bottom side, where the rear spring-loaded plate of said bottom side springs back into a locking position, and thereby locks the rear tongue of the mountain bicycle type shoe cleat thereto. *Ibid.*, lines 27-33, column 3. See also US Patent No. 5,692,415 which is incorporated into the disclosure of Gapinski.

Regarding claim 2, Gapinski teaches a bicycle pedal, comprising:

a. a main body 24 pivotable about a transverse axis and having a spindle bolt 32 for connecting to a bicycle, a first cleat clamp side 28 and a second cleat clamp side 31;

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b. said first cleat clamp side 28 conforming to a bottom of a bicycle road shoe cleat and having a recess 100, 106 (Fig. 3) for receiving a first tongue of the road shoe cleat 22 and a spring-loaded retaining plate 42 pivotable on said main body 24 for receiving a second tongue 46 of the road shoe cleat 22 and when a force is applied to the spring-loaded retaining plate 42, the spring-loaded retaining plate 42 moves away from said main body 26 such that the second tongue engages the spring-loaded retaining plate 42, where the spring-loaded retaining plate 42 springs back into a locking position, and thereby locks the second tongue of the road shoe cleat thereto; and

c. said second cleat clamp side 31 being smaller than said top cleat clamp side 28 and conforming to a bottom of a mountain bicycle type shoe cleat, said second cleat clamp side 31 having a locking member 30 located adjacent to said spring-loaded retaining plate 42 of said top side 28 for receiving a first tongue of the mountain bicycle type shoe cleat and a spring-loaded retaining member (see Exhibit) pivotable on said main body 24 such that a second tongue of the mountain bicycle type shoe cleat engages the spring-loaded retaining member of said second side 31, where the spring-loaded retaining member of said second side 31 springs back into a locking position, and thereby locks the second tongue of the mountain bicycle type shoe cleat thereto. *Ibid.*, lines 27-33, column 3. See also US Patent No. 5,692,415 which is incorporated into the disclosure of Gapinski.

Regarding claim 3, Gapinski teaches a bicycle pedal, comprising:

a. a main body 24 pivotable about a transverse axis and having a spindle bolt 32 for connecting to a bicycle, a first side 28 and a second side 31;

b. said first side 28 conforming to a bottom of a bicycle road shoe cleat and having means 100, 106 (Fig. 3) for receiving a first tongue (see Exhibit) of the road shoe cleat 22 and a

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spring-loaded retaining plate 42 pivotable on the main body 24 for receiving a second tongue 46 of the road shoe cleat 22 and when a force is applied to the spring-loaded retaining plate 42, the spring-loaded retaining plate 42 moves away from said main body 24 such that the second tongue 46 is retained within the spring-loaded retaining plate 42, where the spring-loaded retaining plate 42 moves back into a locking position, and thereby locks the second tongue 46 of the road shoe cleat 22 thereto; and

c. said second side 31 conforming to a bottom of a mountain bicycle shoe cleat and having a locking member (see Exhibit) for receiving a first tongue of the mountain bicycle shoe cleat and a spring-loaded retaining member (see Exhibit) pivotable on said main body 24 such that a second tongue of the mountain bicycle shoe cleat is retained within the spring-loaded retaining member of said second side 31, where the spring-loaded retaining member of said second side 31 moves back into a locking position, and thereby locks the second tongue of the mountain bicycle shoe cleat thereto. *Ibid.*, lines 27-33, column 3. See also US Patent No. 5,692,415 which is incorporated into the disclosure of Gapinski.

Regarding claim 4, said second side 31 is smaller than said first side 28 (Figs. 1-11).

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Baume *et al.*, Beyl, and Nagano which were cited in parent application Serial No. 09/360,561 are recited.

9. Submission of your response by facsimile transmission is encouraged. Group 3600's facsimile number is **(703) 305-7687**. Recognizing the fact that reducing cycle time in the processing and examination of patent applications will effectively increase a patent's term, it is to your benefit to submit responses by facsimile transmission whenever permissible. Such submission will place the response directly in our examining group's hands and will eliminate Post Office processing and delivery time as well as the PTO's mail room processing and delivery time. For a complete list of

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correspondence **not** permitted by facsimile transmission, see MPEP 502.01. In general, most responses and/or amendments not requiring a fee, as well as those requiring a fee but charging such fee to a deposit account, can be submitted by facsimile transmission. Responses requiring a fee which applicant is paying by check **should not be** submitting by facsimile transmission separately from the check. Responses submitted by facsimile transmission should include a Certificate of Transmission (MPEP 512). The following is an example of the format the certification might take:

I hereby certify that this correspondence is being facsimile transmitted to the Patent and Trademark Office (Fax No. (703) 305-7687) on _____

(Date)

Typed or printed name of person signing this certificate:

(Signature)

If your response is submitted by facsimile transmission, you are hereby reminded that the original should be retained as evidence of authenticity (37 CFR 1.4 and MPEP 502.02). Please do not separately mail the original or another copy unless required by the Patent and Trademark Office. Submission of the original response or a follow-up copy of the response after your response has been transmitted by facsimile will only cause further unnecessary delays in the processing of your application; duplicate responses where fees are charged to a deposit account may result in those fees being charged twice.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Luong whose telephone number is (703) 308-3221. The examiner can normally be reached on Monday-Thursday from 8:30 AM EST to 7:00 PM EST.

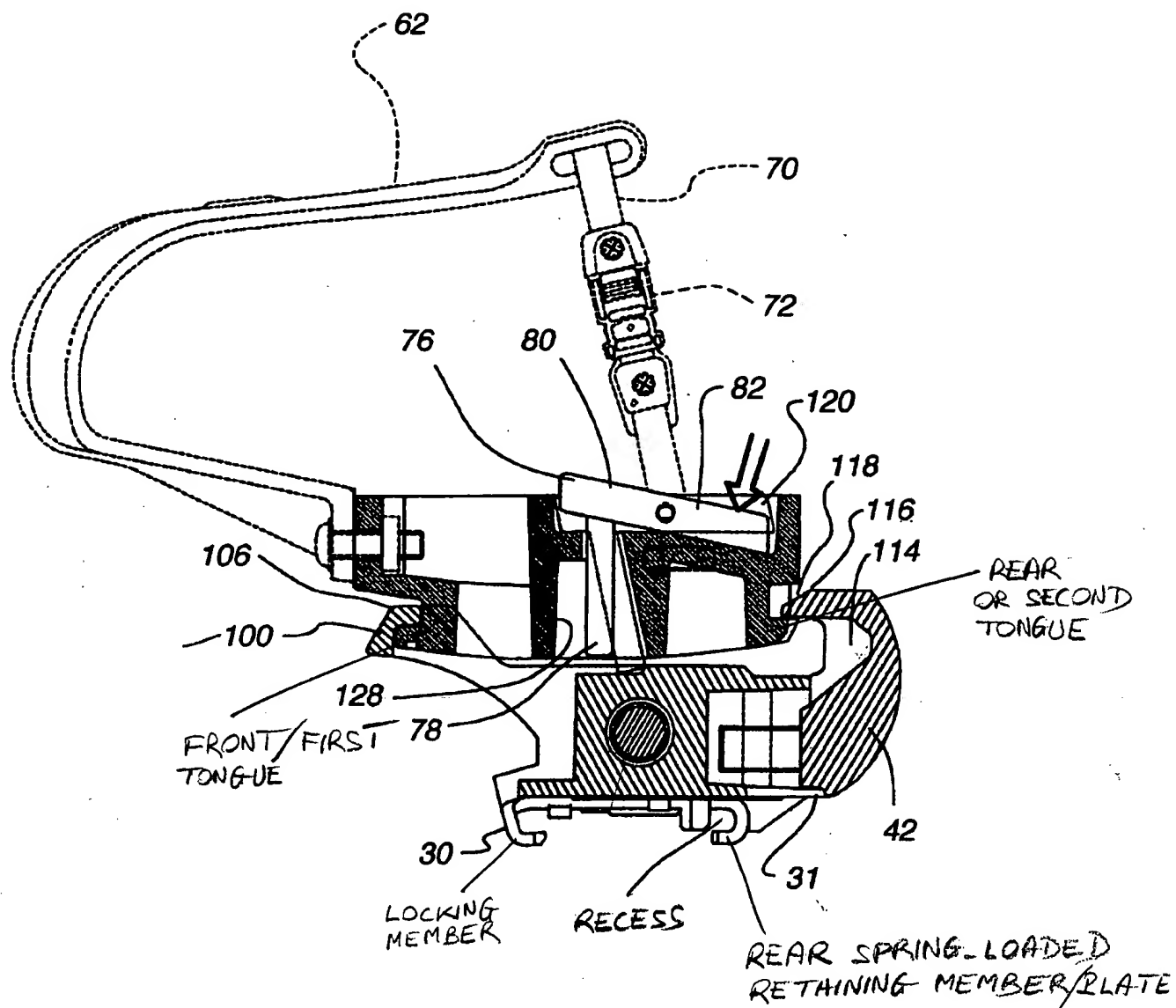
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bucci, can be reached on (703) 308-3668. The fax phone number for this Group is (703) 305-7687. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1113.

Luong

January 13, 2003



Vinh T. Luong
Primary Examiner

**Fig. 3**

EXHIBIT